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RECORD OF ORAL HEARING
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SEUNG-CHEOL HONG and KI-YOUNG JANG

Appeal 2007-1953
Application 09/942,961

Oral Hearing Held: December 19, 2007

20Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and
21JAY P. LUCAS, *Administrative Patent Judges*.

23ON BEHALF OF THE APPELLANT:

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31 The above-entitled matter came on for hearing on Wednesday,
32 December 19, 2007, commencing at 9:00 a.m., at The U.S. Patent and
33 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Carol A.
34 Lowe, RPR, CCR No. 0313084, Notary Public.

PROCEEDINGS

37 JUDGE BARRY: Good morning, Mr. Bushnell.

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1 MR. BUSHNELL: If it please the Board, I am Robert E. Bushnell for
2-- this is Samsung Electronics, Co., Ltd.

3 And this would be the first hearing. The application was remanded to
4the examiner. And the Board had pointed out some questions that are rather
5cogent.

6 The long and the short of it is the examiner requested production of
7references that were used to prepare the application. And he didn't actually
8get around to focusing on any part of the application.

9 And it seemed in the exchange of papers the examiner was asking that
10broadly, not the application for the patent and not specifically the application
11for the re-issue.

12 And I hope it doesn't surprise anyone that the claims in the re-issue
13case are wildly different from the claims in the patent application, the parent.
14I don't think that's a surprise to anyone. Morrie Klitzman from --

15 JUDGE BLANKENSHIP: Well, we have to assume that nothing new
16is being invented in the re-issue application. Is that a fair assumption?

17 MR. BUSHNELL: Nothing new is added; but, you know, things are
18being invented. What Morrie Klitzman from IBM used to explain, that the
19more time an attorney spends on a case the smarter the attorney becomes.

20 JUDGE BARRY: Right.

21 MR. BUSHNELL: And it's not unusual to sit there -- sometimes you
22put these up on your workbench at night. You look at them. And after a
23while you begin to see something different from what you originally
24claimed.

1 And that can lead to all kinds of problems during the original
2 examination; restriction, election of species after the fact and that sort of
3 thing.

4 Here the -- what it came down to, nobody knows where Figure 1
5 originated; but there's no reason to believe it's not the applicant's good faith
6 effort to comply with Rule 83 to describe what he was doing when this idea
7 occurred to him.

8 And if you've never had the honor of working with inventors -- and it
9 doesn't make any difference whether they're graduates of the high school
10 commercial course in cosmetics or whether they're a Ph.D. in physics. It's
11 the same.

12 They spend a lot of time doing what they're doing. And one day they
13 begin to realize there's a problem with it. That's half of it. And they struggle
14 and struggle. And they come up with a solution. It might be the first
15 solution. It might not be the best solution. And usually they keep on
16 working often long after the application is filed.

17 So we can presume that Figure 1 was what the inventors were
18 working with at the time they made their invention.

19 Now, the inventors here went beyond Figure 1. And they figured out
20 that they can put a switch between the heater coil of the cathode ray tube and
21 the power supply.

22 JUDGE BLANKENSHIP: Well, before we get away from Figure 1,
23 there's a -- there was a response filed September 29th, 2006.

24 MR. BUSHNELL: Yes.

25 JUDGE BLANKENSHIP: Do you have that?

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1 MR. BUSHNELL: Yeah. Okay. Not right in front of me. What did I
2 say?

3 JUDGE BARRY: You can take a moment, Mr. Bushnell, if you
4 would like.

5 MR. BUSHNELL: 2006?

6 JUDGE BARRY: For what it's worth, the PTO stamped it as -- on
7 September 29th, 2006.

8 MR. BUSHNELL: Okay. September 19, 2006?

9 JUDGE BLANKENSHIP: September 29th. It's also dated on the
10 second page as the 29th of September '06.

11 MR. BUSHNELL: Okay. Response filed.

12 JUDGE LUCAS: Did you find it, Mr. Bushnell?

13 MR. BUSHNELL: Yes, I have that. It's a two-page response.

14 JUDGE LUCAS: Correct.

15 MR. BUSHNELL: Okay.

16 JUDGE BLANKENSHIP: Right. On page 2, the second paragraph.

17 MR. BUSHNELL: Yes.

18 JUDGE BLANKENSHIP: Why is not -- why isn't that Section 103
19 prior art?

20 MR. BUSHNELL: Okay. Prior art, as the Board did point out in its
21 remand --

22 JUDGE BARRY: Actually, for the record, why don't we just go
23 ahead and read that. Do you want to read that into the -- that sentence into
24 the record, please?

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1 MR. BUSHNELL: Applicant believes that the power management
2control apparatus illustrated in Figure 1 is simply an example of a power
3management control apparatus that was well known by people with ordinary
4skill in the art at the time of applicant's invention, period.

5 Now, "prior art" is a rather technical term. It's defined under 35
6U.S.C. Section 103. By reference there are several paragraphs of 102. So
7the fact that something is old does not make it prior art under 102. The fact
8that it's well known in the community does not make it prior art under 102.

9 We have a one-year grace period. And applicants are fairly diligent in
10getting these applications filed well before they're outside of that one-year
11period. So I can't say Figure 1 is prior art.

12 JUDGE BLANKENSHIP: That's for the applicant's own work,
13though.

14 MR. BUSHNELL: Pardon?

15 JUDGE BLANKENSHIP: Isn't the grace period for the applicant's
16own work? Not for something that one of ordinary skill in the art would
17know.

18 MR. BUSHNELL: Well, there's more than one entity working on any
19particular problem at any one time. And I've had a number of cases over the
20years unrelated where two people came up with essentially the same
21invention, not ideal -- or, excuse me, not identical.

22 But the examiner called up and said, now, here's the attorney's name
23out in San Francisco and he's got a case pending with this or whatever. One
24time it was NASA. Both inventors were NASA. So we figured out who
25was first and that sort of thing.

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1 But that happens. But it's still -- neither one is prior art. But they
2 came up with their solution. They reduced it to practice at least
3 constructively by filing within the short period of time.

4 And what they were doing when they made that invention may very
5 well be the subject matter of an earlier application. It's hard to say, because
6 we don't do all the applications for this particular applicant. But I did
7 search. And I couldn't find any evidence that they've ever filed this.

8 What the Board is really getting at on Figure 1 are these different
9 power states. Now, the Board struggled with that years and years ago in a
10 completely different application. Fortunately, it is also the subject of re-
11 issue application and appeal, maybe a second appeal. I don't know.

12 And I think the long and the short of it is the Board said, yeah, there's
13 power-on states, there's power, whatever, standby states when power is
14 applied to some of the monitor and not others; that sort of thing.

15 It's a much different case and, I believe, different inventors; but this --
16 that's what you're getting at.

17 So if -- what we need to do here is to distinguish the claims over the
18 examiner's proposed combination of Figure 1 modified according to the 680
19 reference or -- excuse me. Yeah, 630 reference.

20 JUDGE BARRY: Counsel, is that a related case or is it based on the
21 same spec?

22 MR. BUSHNELL: No, it's not related at all.

23 JUDGE BARRY: Okay.

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1 MR. BUSHNELL: It was a case that the Board had originally -- I
2think it was filed like '89 or '90. And the Board's original decision was only
3on one claim. It was Examiner Buczinski.

4 And by the time it got up here he had allowed all but one claim. And
5the Board reversed that rejection. And I think they gave -- there were two
6102 references. And the Board gave five reasons for the one reference
7distinguished over and four for the other.

8 All that is the subject of re-issue recapture now, whether the Board by
9reversing created a re-issue recapture; but that's a different case.

10 The point of it is that the Board recognized pretty much *sua sponte*,
11that is, on its own, that there were these different levels of power applied to,
12for example, a television set, not specifically a cathode ray tube.

13 Now, the examiner went and -- I guess I have to assume he -- unlike
14the typical case when I come up here, where should the examiner search, I
15guess he found the best start he could, because it seems cogent.

16 The deficiencies are -- we now have some more guidance from John
17Deere and KSR. This is not KSR. There's no Asano reference that was not
18considered by the examiner here.

19 In Asano the Supreme Court fully considered nine different patent
20references in detail. And they said that you've got to do that which I gather
21that the CSC, for whatever reason, didn't start dissecting the nuts and bolts
22of each of those references.

23 Often it will be necessary for a court to look at the inner-related
24teachings of multiple patents all in order to determine whether there was
25apparent reason to combine the known elements in the fashion claimed in

1the patent at issue. And then they said to facilitate its review the analysis
2should be made explicit.

3 So what we've got -- and the court recognized, the Supreme Court, a
4patent is composed of several elements. And it's not proved obvious merely
5by demonstrating that each of its elements was independently known in the
6prior art.

7 And then they go off and invoke common sense. Okay. It's a rather, I
8guess, helpful bit of guidance to us that we've got to look at these references
9carefully.

10 Now, the examiner's secondary reference is, as the Board pointed out
11in its remand -- the Board was considered -- about claim 11 which is broad.

12 And the examiner's secondary reference is cutting power, as it says. It
13has a power switch 40 best illustrated in Figure 3 of his drawings. It's the
14upper right-hand corner. There's an inverter 96 coming out of the switch.
15And it controls the -- I guess the light-emitting diode. It's not numbered in
16the 102, the optical coupler. And you only have one lead from power supply
1722 to the monitor, 12.

18 Now, remember that the Board --

19 JUDGE BLANKENSHIP: Excuse me. Were these arguments
20presented in the brief?

21 MR. BUSHNELL: Pardon?

22 JUDGE BLANKENSHIP: Were these arguments presented in the
23brief?

24 MR. BUSHNELL: Yeah. Yes, they were. I didn't write the brief, but
25they were in detail.

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1 JUDGE BARRY: Maybe for when we go back to decide perhaps you
2can point out where as you go along.

3 MR. BUSHNELL: Sure. But they're also presented in the claim.

4 Now, what the broad claim 11 talks about -- it's a power supply
5providing power to the heater; a switch disposed between the power supply
6and the heater switching off power provided for the heater.

7 Now, the secondary reference doesn't talk about a heater. Now, you
8did provide in your remand a detailed explanation of cathode ray tubes. And
9they call them triodes and tetrodes, but the thing they have in there
10uniformly is what's called an indirectly heated cathode. That's where the
11heater is.

12 This is kind of high school electronics or whatever. You also have
13directly heated cathodes. And there's no heater. The problem with the
14primary or, excuse me, the secondary reference is if you look at the
15reference, the textbook that you provided in the remand, you've got grids.
16Some of them have two grids. Some have three. And then there's the anode.

17 Now, you've got to have a potential difference. And it's substantial, a
18thousand volts or plus -- more than a thousand volts between the cathode
19whether it's directly heated with a -- or whether it's indirectly heated as this
20claim envisions.

21 JUDGE BLANKENSHIP: Well, actually, I found those arguments in
22the brief. Like page 29 of the brief --

23 MR. BUSHNELL: Okay. We did --

1 JUDGE BLANKENSHIP: -- it addresses -- it addresses claim 11.
2 And it says that the rejection is error because the examiner improperly relied
3 on Figure 1 of the specification.

4 MR. BUSHNELL: Right. You're on page 29?

5 JUDGE BLANKENSHIP: Right.

6 MR. BUSHNELL: Okay. Okay. All right.

7 Now, all of these other pages are -- even though they're denominated
8 with a subheading referring to a particular claim, they've got, what, 10
9 independent claims in here? 11 is just the broadest claim.

10 These other arguments are not excluded from consideration in the --
11 for the reasons for allowance of claim 11.

12 JUDGE LUCAS: I'm sorry, Mr. Bushnell.

13 MR. BUSHNELL: The fact that --

14 JUDGE LUCAS: May I interrupt for a second?

15 MR. BUSHNELL: Sure.

16 JUDGE LUCAS: You are making a point between directly and
17 indirectly heated cathodes.

18 MR. BUSHNELL: That's correct.

19 JUDGE LUCAS: Am I -- are you reading something into claim 11
20 that I don't see? Because all I see in claim 11 --

21 MR. BUSHNELL: No. Claim 11 has a directly heated cathode.

22 JUDGE LUCAS: It doesn't even say directly or indirectly. It just
23 says a heater.

24 MR. BUSHNELL: Excuse me. An indirectly heated. "Heater" is
25 intrinsic to indirectly heated cathode, the same as the treatise you gave us.

1Okay. But that's not the only electrode in a cathode ray tube of a monitor.

2Okay.

3 JUDGE LUCAS: But are you saying that because of some reference
4in the spec "heater" in claim 11 refers only to indirectly and not directly or is
5it --

6 MR. BUSHNELL: Well, you don't have a heater in the directly
7heated.

8 JUDGE LUCAS: Well, every cathode has to be heated.

9 MR. BUSHNELL: Well, it's a cathode that would be directly --

10 JUDGE LUCAS: The cathode itself is the -- is the heat source.

11 MR. BUSHNELL: Well, okay, you can say that. And that would
12broaden the scope of claim 11. And I would appreciate it if you would,
13but --

14 JUDGE LUCAS: But you don't believe that that's a reasonable
15reading for rejection purposes of claim 11?

16 MR. BUSHNELL: You could do that; but that's not my point, though.
17My point is the examiner's proposed combination is interrupting a single
18source of voltage to a monitor. And he's not specifically saying where that
19voltage is applied whereas we've got, what, five or more anodes --

20 JUDGE BARRY: Mr. Bushnell, again, just to help us for when we go
21back to deliberate --

22 MR. BUSHNELL: Yeah.

23 JUDGE BARRY: -- where -- would you point to a page or a
24paragraph where -- that just sort of capsulizes the argument you're making
25now?

1 MR. BUSHNELL: Okay. I'll try to. Can I do that with a single
2supplemental after I leave here? Would that be okay?

3 JUDGE BARRY: No. No. We need that --

4 MR. BUSHNELL: Because we did that before. And it took like 20
5minutes to go through on a different case.

6 JUDGE BARRY: Well, our concern is that we can't -- we can't have a
7new argument being made here at the oral hearing.

8 MR. BUSHNELL: Okay. That -- yeah, that's your concern; but
9there's a reason for the oral hearing. We have like 800 years of common law
10as to what the purpose of the oral hearing is and the fact that what's argued at
11the oral hearing cannot be ignored.

12 And, you know, quite often it's very helpful. And the Board does cite
13-- other times they tend to say, well, that's a newly raised attorney's
14argument.

15 JUDGE BARRY: Well, the former would be permissible; but the
16latter would not. We cannot entertain -- our hands are tied here. We cannot
17entertain a new argument at the oral hearing. So I think what Judge
18Blankenship is trying to ensure is that --

19 MR. BUSHNELL: That we address this issue.

20 JUDGE BARRY: Yes.

21 MR. BUSHNELL: Well, I think in the efficacy of the prosecution,
22okay, we'll do it. Let me go through the brief then.

23 JUDGE BARRY: Our time is almost up. So if you want to just
24summarize, that's fine, too.

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1 MR. BUSHNELL: Okay. What we have here, applicant for whatever
2reason realized there was an advantage to cutting power to the heater. Okay.
3And they did that. How did they do it? They put a switch here.

4 What the examiner has done is suggest taking what the applicant was
5doing at the time he made his invention -- taking only the switch and cutting
6the power to the heater. There -- unlike what KSR had, there's no standard
7switch.

8 JUDGE BARRY: Okay.

9 MR. BUSHNELL: The sensor in KSR was well known. It did the
10same thing in nine different applications. That's not what we have here.

11 JUDGE BARRY: Okay. Thank you, Mr. Bushnell.

12 MR. BUSHNELL: Sure.

13 JUDGE BARRY: Do you want --

14 MR. BUSHNELL: Excuse me. KSR wasn't available when this thing
15was briefed.

16 JUDGE BARRY: Do you want the -- do you want the supplemental
17brief that he's offering, Mr. Blankenship?

18 We are -- since Judge Blankenship is the only judge from the original
19panel, he's the most --

20 MR. BUSHNELL: Oh, I'm sorry. I thought --

21 JUDGE BARRY: That's why I keep asking him. That's why we're --
22for us this is sort of our first impression. That's why I keep deferring to him.

23 MR. BUSHNELL: Okay.

24 JUDGE BARRY: But if he doesn't find it necessary --

25 MR. BUSHNELL: Okay. I'd be happy to do that.

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1 JUDGE BARRY: Okay. Thank you, sir.

2 MR. BUSHNELL: Thank you.

3 (Whereupon, the proceedings at 9:22 a.m. were concluded.)

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